

Final rejection is proper on a second action when except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). See MPEP 706.07(a).

In the Office action dated December 1, 2006, the claims were rejected over a combination of Kobayashi (US 2002/0173281) in view of Matsumura et al (US 5,652,766). In the response filed on February 27, 2007, Applicant distinguished over said combination of references on several grounds. In addition, to improve clarity, claim 1 was amended to recite that the sliding member "moves" between a third position and a fourth position instead of "rotates."

Applicant notes that the alleged "sliding member" in Matsumura as identified by the Examiner in the previous Office action does in fact "move." However, among other differences set forth in the previous response, the alleged "sliding member" does not move (or rotate) between a third position and a fourth position so as to rotate a transmitting member.

Furthermore, Applicant notes that in the Office action dated May 14, 2007, the Examiner asserts that "Okuda et al fail to disclose a sliding member disposed in the body in a manner such that the sliding member **rotates** between a third position and a fourth position ..." See page 3, second paragraph [emphasis added]. It is thus evident that the amendment from "rotate" to "move" was not itself the reason for applying new art.

In sum, Applicant submits that the amendment to claim 1 played no part distinguishing over the references and did not necessitate a new prior art search or grounds for rejection.

#### Rejections Under 35 U.S.C. 103

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuda in view of Duarte. Applicant respectfully traverses the rejections for the reasons as follow.

The office action fails to establish a *prima facie* case of obviousness in that all the claim limitations are not taught or suggested by the prior art.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claim 1 recites a folding electronic device comprising a body, an upper housing portion, a transmitting member, a first elastic member, and a sliding member. The upper housing portion is disposed on the body in a manner such that the upper housing portion rotates between a closed position and an open position. The transmitting member is disposed between the body and the upper housing portion in a manner such that the transmitting member rotates between a first position and a second position. The upper housing portion rotates along with the transmitting member. The first elastic member is disposed between the transmitting member and the body so as to rotate the transmitting member to the second position. The sliding member is disposed in the body in a manner such that the sliding member moves between a third position and a fourth position so as to rotate the transmitting member. The sliding member is engaged with the transmitting member located in the first position when the sliding member is located in the third position. The sliding member is disengaged from the transmitting member so that the transmitting member rotates to the second position by the first elastic member and the upper housing portion rotates to the open position from the closed position when the sliding member is moved to the fourth position from the third position.

Claim 17 recites a folding electronic device comprising a body, an upper housing portion, a transmitting member, a first elastic member, and a sliding member. The upper housing portion is disposed on the body and rotatable between a closed position and an open position. The transmitting member is disposed between the body and the upper housing portion and rotatable between a first position and a second position. The transmitting member and the upper housing portion are arranged such that the upper housing portion is rotated along with the transmitting member. The upper housing portion is in the closed position when the transmitting member is in the first position, and the upper housing portion is in the open position when the transmitting member is in the second position. The first elastic member is disposed between the transmitting member and the body and biased to rotate the transmitting member to the second

position. The sliding member is disposed in the body and slidable between a third position and a fourth position. The sliding member and the transmitting member are arranged such that the sliding member is engaged with the transmitting member when the transmitting member is located in the first position while the sliding member is located in the third position, the movement of the sliding member from the third position to the fourth position presses the transmitting member to rotate from the first position to an intermediate position between the first position and the second position, and the sliding member is disengaged from the transmitting member when the sliding member reaches the fourth position such that the transmitting member is rotated from the intermediate position to the second position by the first elastic member.

Okuda discloses a foldable portable telephone comprising a main body case 1 and a closure case 2 connected to the main body case 1. Arranged at the junction of the main body case 1 and the closure case 2 is a hinge mechanism 10 comprising a hinge assembly 4. The hinge assembly 4 comprises a main body drive member 44. A shank 45 extends leftward from the left side face of the flange 44b of the main body drive member 44. Provided around the shank 45 is a prime mover spring 5. As the Examiner stated, Okuda fails to disclose a sliding member.

Duarte discloses a sliding display apparatus including a display 102 and a base 104. The base 104 includes a track 106. The display 102 includes an engagement 108 that engages the track 106. The display 102 also has a link 110 that is attached to the display 102 and the base 104

In the rejections, the Examiner relies on Duarte to teach the sliding member and its arrangement in connection with the transmitting member, as recited in claims 1 and 17. However, while the rejections point to figures 1a-1g and col. 2, line 43 to col. 3, line 31 of Duarte as teaching these limitations, no specific reference is provided with regards to what the Examiner considers to be the sliding member, the transmitting member, or the arrangement thereof corresponding to that recited in the claims.

For the sake of argument, Applicant will assume that the Examiner is referring to engagement 108 and link 110 as the alleged "sliding member" and "transmitting member" of claims 1 and 17. However, in Duarte, the engagement 108 is always located in the track 106, and the link 110 is always attached to the display 102 and the base 104. Thus, Duarte does not disclose that the

sliding member is ***disengaged*** from a transmitting member so that the transmitting member ***rotates to the second position by a first elastic member***, as recited in the claims.

More particularly, in Duarte, the display 102 is moved to the open position by constant pressure applied to the display 102. In contrast, in claims 1 and 17 of this application, the sliding member rotates the transmitting member when the sliding member moves/slides between the third position and the fourth position. After the sliding member is disengaged from the transmitting member (i.e., when it reaches the fourth position), the transmitting member is rotated by the first elastic member. This arrangement is not found in Okuda, Duarte, or the combination thereof.

The office action fails to establish a *prima facie* case of obviousness in that it does not establish suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Also see MPEP 2143.01. In the *Ratti* decision, the court held that the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate."

The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings Duarte into the teachings of Okuda so that the mobile terminal can be opened and closed by applying pressure to a forward end (i.e. sliding mechanism) to open the mobile terminal allowing for easier access to the controls of the mobile terminal. Applicant respectfully disagrees.

Okuda discloses that the closure case 2 can be opened at the touch of the manual button 41 of the hinge assembly 4. Abstract, lines 18-19. Duarte, on the other hand, discloses that the display 102 moves as pressure is applied to the display 102. At column 2, lines 63-64. The operation and structure of each of these two opening mechanisms is entirely different and

unrelated. In particular, Duarte's alleged "sliding member" could not be incorporated into Okuda's foldable portable telephone without a complete redesign of the later.

Furthermore, as noted above, claims 1 and 17 recite a structure having a two stage opening wherein 1) the sliding member rotates the transmitting member when the sliding member moves between the third position and the fourth position, and 2) after the sliding member is disengaged from the transmitting member (i.e., when it reaches the fourth position), the transmitting member is rotated by the first elastic member. Where is the motivation for modifying Okuda to implement an arrangement of a sliding element and a transmitting element having a two stage opening?

In this regard, the Federal Circuit has stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). Furthermore, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior so that the claimed invention is rendered obvious. *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). It is the Applicant's belief that the present rejection fits the Federal Circuit's description of an impermissible rejection under §103. Namely, the Examiner has simply listed certain elements of the present invention and then located isolated disclosures of those components.

In particular, the Examiner has simply located a reference with a sliding element and combined it with an incompatible opening mechanism, wherein the modifications necessary to actually implement the sliding element to obtain a two stage opening as recited in the claims all come from Applicant's own disclosure. More particularly, nowhere in the cited art is there disclosed an arrangement of a sliding member that, *inter alia*, 1) causes rotation of a transmitting member when moved/slid from a third position to a fourth position, and 2) is disengaged from the transmitting member at the fourth position such that an elastic member causes further rotation of the transmitting member.

For at least these reasons, claims 1 and 17 patently define over the cited art. Since the prior references do not disclose all the limitations of claim 1, claims 1-16 patently define over the

cited art for at least the same reasons.

Conclusion

For the reasons described above, the Applicant believes that the application is now in condition for allowance and respectfully requests so. The Commissioner is authorized to charge any additional fees that may be required or credit overpayment to Deposit Account No. **502447**.

Respectfully submitted,

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